TTAB

Docket No. 22HF-165423-912

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Summit Entertainment, LLC Serial No: 85/813,593 Filed: January 1, 2013 Class: 9 Mark: INSURGENT	Examiner: Mark Sparacino Law Office: 103 **APPLICANT'S REPLY BRIEF**

Applicant Summit Entertainment, LLC ("Applicant") hereby submits this reply brief in support of its appeal of the Examiner's refusal to register Applicant's trademark INSURGENT in Class 9 under § 2(d) of the Trademark Act on the ground that it is likely to cause confusion, to cause mistake, or to deceive with U.S. Registration No. 4,392,625 for INSURGENCY for "computer game software for personal computers and home video game consoles" in Class 9 owned by Jeremy A. Blum ("Cited Mark").

I. THE REFUSAL TO REGISTER SHOULD BE REVERSED

A. The Examiner Has Not Met His Burden of Demonstrating That Applicant's Mark And The Cited Mark Are Confusingly Similar

The Office bears the burden of showing that a mark falls within the statutory bars of Section 2(d). J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fourth Ed.) § 19:75 at 19-230. To refuse registration under Section 2(d), the Examiner "must present sufficient evidence and argument that the mark is barred from registration." *Id.* § 19:128 at 19-383. Here, respectfully, the Examiner has not met his burden.

A. Applicant's Limitation of Goods to Those "All Relating to Motion Pictures and Entertainment Concerning Motion Pictures" Sufficiently Distinguishes its Goods from Registrant's Goods

Applicant has applied to register INSURGENT for "computer games, namely computer game cartridges, cassettes, tapes, discs, programs and software, downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing, and organizing electronic games, and electronic games downloadable via the internet and mobile devices and video games, namely video game cartridges, discs and software, **all relating to motion pictures and entertainment concerning motion pictures**" in Class 9 (emphasis added). The Examiner's contention that Registrant's goods are "effectively identical" to Applicant's goods is incorrect. (Opposition, p. 9.)

The Examiner's evidence of record does not establish that Applicant's goods, as limited to goods "all relating to motion pictures and entertainment concerning motion pictures," are "identical" or even related to Registrant's goods.

First, the Examiner has not cited any cases where computer games and any other goods in Class 9 "all relating to motion pictures and entertainment concerning motion pictures" have been determined to be similar or related to computer game software for personal computers and home video game consoles. Furthermore, the Examiner has not cited any cases addressing the relatedness to goods "all relating to motion pictures and entertainment concerning motion pictures" to *any unrestricted identification of goods* in Class 9.

Second, the Examiner has not made of record any web pages or other evidence purportedly reflecting use in commerce where computer games and any other goods in Class 9 "all relating to motion pictures and entertainment concerning motion pictures" are offered under the same brand as computer game software for personal computers and home video game consoles.

Third, the Examiner has not made of record any third party registrations in which downloadable widget programs, downloadable electronic games, computer games and video games in Class 9 "all relating to motion pictures and entertainment concerning motion pictures" are included in the same registration as computer game software for personal computers and home video game consoles in Class 9 in general. Likewise, the Examiner has not identified any registrations in which *any goods* "all relating to motion pictures and entertainment concerning motion pictures" are included in the same registration as computer game software for personal computers and home video game consoles.

The Board has recently held that "associated with" language in the identification of goods or services may be "precatory language, and not binding on consumers" when encountering a particular mark if the language does not alter the nature of the goods or represent that the goods will be marketed in any particular limited way, or through limited trade channels or to any particular class of consumers. *See In re i.am.symbolic, llc*, 2015 TTAB LEXIS 369 at *10 (Oct. 7, 2015).[1] Applicant respectfully submits that the present limitation, "all relating to motion pictures and entertainment concerning motion pictures" contains a meaningful limitation that would be reflected in the relevant marketplace. Applicant's restriction of its widget programs and computer and electronic games in Class 9 to those "all relating to motion pictures and entertainment concerning motion pictures" means that Applicant's goods are limited to ones marketed in connection with motion pictures and entertainment. This is an express limitation in the identification of goods. Similarly, Applicant would be precluded from renewing its registration of INSURGENT for widget programs and computer and electronic games in Class 9 that are not marketed in connection with motion pictures and entertainment. Applicant's

[1] The Board's decision in In re i.am.symbolic, llc is under appeal to the U.S. Court of Appeals for the Federal Circuit. *See* TTAB Ex Parte Appeal No. 85/044,494, Dkt. No. 42.

marketing of its widget programs and computer and electronic games in Class 9 must have a connection to motion pictures and entertainment in order to assert valid trademark registration rights in its mark. In other words, Applicant is bound by the language in its identification of goods to advertise and sell goods that do in fact relate to motion pictures and entertainment. This in turn means that the relevant consumers will only encounter goods from Applicant that are *Insurgent* Motion Picture branded merchandise. Further, Registrant's marks cannot be associated with the *Divergent* Motion Pictures, lest Registrant willfully or negligently intends to violate Applicant's rights associated with the *Divergent* Motion Pictures.

This limitation is the identification of goods weighs in favor of a finding that there is no likelihood of confusion between Applicant's mark and the Cited Mark.

B. <u>The Meaning of the Respective Marks is Different</u>

The Examiner argues that the meaning of the Cited Mark and Applicant's Mark is the same. Not so. The Cited Mark is an obvious reference to the Insurgency of troops in the Iraq war, which began in 2003 and lasted until 2011, which led to the then defeat of enemy combatants in Iraq. The Insurgency was highly publicized by the media and politicians as a success story for American troops. Registrant's game and the name of it clearly draws upon that meaning, as shown by the specimens submitted with his application. (Request for Reconsideration, December 5, 2014, Ex. C); (Response to Office Action, May 5, 2014, Ex. 1). Indeed, given its widespread common knowledge amongst the American public, the Board should take judicial notice of the Insurgency in the Iraq war. Fed.R.Evid. 201(1).

The Examiner contends that extraneous evidence of Registrant's use of the mark for computer games cannot be considered. However, the evidence relied upon by Applicant is part of the file history for the Cited Mark and was clearly considered by the Office in issuing the registration of the Cited Mark. It therefore should be considered here in determining the meaning of the Cited Mark, using dictionary definitions. Notably, the Examiner points to

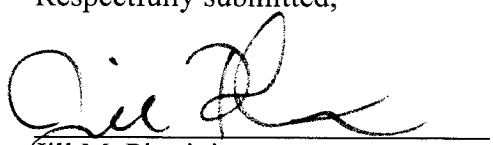
extraneous evidence of his intended meaning of Registrant's mark. It is unfair to Applicant for the Office to use extraneous evidence itself to make an argument in support of a refusal to register and then preclude Applicant from relying on evidence the Office, in fact, considered in issuing the registration of the Cited Mark to traverse such refusal.

Accordingly, Registrant's specimens submitted with his application, along with the common knowledge of the term Insurgency and its reference to the Iraq war, should be considered to determine the meaning of Registrant's mark. When those two things are considered, it is obvious that the Cited Mark refers to a military insurgency of troops against enemy combatants. Otherwise, the Office will be allowed to rely upon an interpretation of the Cited Mark using extraneous dictionary definitions to assign meanings to the Cited Mark and Applicant's mark.

C. Conclusion

For the reasons stated above, in its opening brief, and in all of Applicant's other documents and evidence, Applicant respectfully requests that the Board reverse the decision of the Examiner and allow the mark to proceed to publication. Applicant requests oral argument and has previously separately filed a Request for Oral Argument.

Respectfully submitted,



Dated: January 15, 2016

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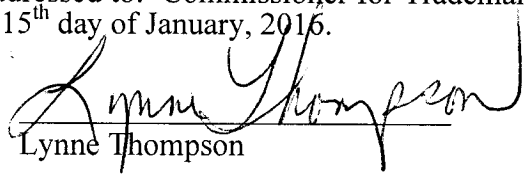
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on this 15th day of January, 2016.



Lynne Thompson

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